

**AMENDMENTS TO THE DRAWINGS**

Figures 2B and 3B have been amended to recite that the license files are transparently transmitted or renewed.

### **REMARKS**

Reconsideration of the application is respectfully requested.

#### **I. Status of the Claims**

Claim 10 was previously cancelled.

Claims 1 and 11-22 have been amended and the amendments do not add new matter,

Claims 1-9 and 11-22 are pending in the application.

#### **II. Status of the Specification and Drawings**

The Specification and Figures 2B and 3B have been amended to recite that steps 216 and 320 are performed “transparently.” The steps embody “transparent transmission” and “transparent renewal” of license files. No new matter is added. Support for the amendments can be found in claim 1 as originally filed and the amendment is permitted under MPEP § 608.01(I), as argued below.

#### **III. Rejections under 35 U.S.C. § 112, First Paragraph**

Claims 1-9 and 11-22 are rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.<sup>1</sup> The Examiner admits that a definition of “transparently” is “without notifying a user.” The Examiner then states that since there are other definitions of “transparent,” Applicants are required to amend the specification to recite “without

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<sup>1</sup> Applicants assume that the Examiner is rejecting all claims under 35 U.S.C. § 112, first paragraph. The Examiner’s position is unclear since he first states that claims 1-9 and 17-20 are rejected. The Examiner then describes the rejection to claims 1 and 19-22 and further rejects dependent claims 2-9 and 11-18.

notifying a user.” However, the Examiner then contends that there is no support for changing the specification to “without notifying a user” for renewing or updating a license file. Applicants respectfully traverse this rejection.

A table comparing the three definitions of “transparent” is set forth below.

<u>TRANSPARENT</u>		
WEBOPEDIA	MICROSOFT PRESS COMPUTER DICTIONARY	NEWTON'S TELECOM DICTIONARY
<p><b>Invisible.</b><sup>2</sup> In computer software, an action is transparent if it takes place without any visible effect. Transparency is usually considered to be a good characteristic of a system because it shields the user from the system's complexity.</p>	<p>Pertaining to, or characteristic of a device, function, or part of a program that works so smoothly and easily that it is <b>invisible</b><sup>2</sup> to the user. For example, the ability of one application to use files created by another is transparent if the user encounters no difficulty in opening, reading, or using the second program's files or does not even know the use is occurring.</p>	<p>Fine or sheer enough to be seen through. Something that is transparent exists for some reason, but is <b>invisible</b><sup>2</sup>, or nearly so. In other words, it does not impair or affect the users' operation of the system or feature. In fact, the user need not interact with the transparent feature, and generally is totally unaware that it exists. Think of a pane of glass that serves to protect the interior of a building and its occupants from the elements, but does not affect the user's ability to see through it.</p>

<sup>2</sup> To add further semantics, the definition of “invisible” is “incapable by nature of being seen; inaccessible to view; hidden; [and] imperceptible, inconspicuous.” Merriam-Webster On-Line Dictionary, (<http://www.m-w.com/cgi-bin/dictionary?va=invisible> last visited December 13, 2005)

As can be seen from the table, there is, in contrast to the Examiner's contention, generally one definition of the term "transparent" in the context of computer and telecommunication technology. All three definitions recite that the function is "invisible," which, as defined above, means the user is "totally unaware that [the function] exists." Thus, Applicants submit that there is only one definition known to those of ordinary skill in the computer and telecommunication art for the term invisible and that definition is that the process is invisible to a user when it happens "without notifying a user" so the user is "unaware."

Applicants respectfully disagree with the Examiner's contention that there is a second definition of the term "transparent," i.e., "the ability of one application to use files created by another ..." This "definition" is an example set forth to help the user understand the term in context.

Furthermore, Applicants disagree with the Examiner's contention that the Specification is silent regarding transparently renewing or updating file or renewing or updating "without notifying a user." Applicants respectfully submit that the support for the claims that currently recite "transparently transmitting the license file to the user" and "transparently renewing the parameters in the license file" comes from the original claim as filed. Additionally, MPEP § 608.01(I) permits the Applicants to amend both the Specification and Drawings to recite the subject matter in the original claim to then provide support for the current claims. MPEP § 608.01(I) recites:

In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it.

Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and

Regarding the caveat in MPEP § 608.01(l) stating that the “disclosure in the claim must be sufficiently specific and detailed to support the necessary amendment of the drawing and description,” Applicants submit that the original claim is sufficient in detail to support any amendment required by the Examiner. The original claim recites both “transparently transmitting” and “transparently renewing” license files. As argued above, the term “transparent” has a single meaning in the computer and telecommunication arts. If the Examiner continues to contend that the word has multiple conflicting definitions, Applicants previously argued, and continue to do so, that the Specification provides enough support to allow one of ordinary skill to apply the definition of “without notifying a user.” There is *literal* support for transmitting license files “without notifying a user” in the Specification, page 8, lines 7-8. Further *literal* support can be found for “transparently renewing” license files in the Specification, page 4, lines 13-14.

Thus, Applicants respectfully submit original claim 1 provides enough support to fulfill the written description requirement. Further, independent claims 1, and 19-22, currently in the application, contain terms that are adequately defined and described in the Specification to convey to one of ordinary skill in the art that the Applicants were in possession of the claimed invention at the time the application was filed. Further claims 2-9 and 11-18 depend from the independent claims 1 and 21 and are allowable based on the same arguments presented above for the independent claims.

Claims 1-9, 17-20, and 22 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. Specifically, the Examiner contends that the Specification is silent regarding “renewing the parameters transparently” and “update said license file parameter transparently.” Further, the Examiner contends that the Specification does not provide one of ordinary skill in the art the “necessary data” for implementing transmitting a license file transparently. The Examiner then contends that the Applicants teach, through the specification and figures, that a user has knowledge of the license files. Applicants respectfully traverse the rejection.

Applicants repeat that there is literal support in the Specification for transparently transmitting and renewing files (see, above, and all previous responses). Additionally, to aid in the Examiner’s understanding of the disclosure, Applicants have amended both the Specification and Figures to now clearly recite that certain steps happen “transparently.” Support for these amendments comes from the Specification as filed, as well as the original claim. As argued above, MPEP § 608.01(l) permits that the:

[A]pplicant may rely ... on the original claims if their content justifies it.  
Where subject matter not shown in the drawing or described in the description is claimed in the application as filed ... requirement[s should be] made to amend the drawing and description to show this subject matter. ... It is the drawing and description that are defective, not the claim.

Thus, Applicants’ disclosure no longer “suggests” (although Applicants submit that it never did suggest) that the user has knowledge of the license file during the transmission or renewing steps.

Further, Applicants submit that the Examiner’s statement that “it is not clear to one of ordinary skill whether the user never has knowledge of the license, is not informed of the specific download, or somewhere in-between” is not relevant to the claims. Applicants claim that it is the license file which is “transparently transmitted” or “transparently renewed.” Applicants do not

claim the “status” of the license file (i.e., if it is transparent or not) outside these two steps. Applicants submit that the user can, at any point along the method, be aware or unaware of the license file, as long as the user is not notified or aware of the transmission or renewal of the license file. Support for matters unclaimed is outside the scope of this rejection.

Applicants previously submitted and reiterate that the prior art illustrates that the “transparent” handling of files is known and within the knowledge of one of ordinary skill in the art. Thus, the Specification, along with the knowledge of one of ordinary skill in the art enables one to make and practice the invention.

For example, U.S. Patent No. 6,519,624 (“the ‘624 patent”), filed in the U.S. over 1 ½ years before the present application, discloses a data transmission/receiving system for exchanging data records between two computer nodes transparently. The disclosure of the ‘624 patent describes the method and system to switch between communications networks but does not provide detailed information on how the switching and transmission is performed “transparently.” The transparent nature of the invention is not described in detail, but independent claims 12 and 14 of the ‘624 patent recite elements of “switch[ing] transparently” and “transparent switching” which suggest that there is enough support to describe and enable the “transparent” element of the claims.

Further, the Examiner cited U.S. Patent No. 5,790,664 to Coley et al. (“Coley”) against the present claims. The Coley reference uses the term “transparently” in the same manner as the present Specification and claims. Coley does not provide any detailed description of how to transmit transparently, yet the Examiner considers the reference sufficiently enabled to formulate a rejection. Applicants respectfully submit that if Coley is sufficiently enabled to be used as a

Applicants continue to assert that one of ordinary skill in the art possesses the knowledge to transparently transmit a file to a user and that the present claims are enabled for one of ordinary skill in the art. The disclosure of both the present Specification and the '624 patent illustrate that the basic concept of transparently transmitting a file is well known, such that the mechanics of such a process need not be described in detail. Applicants submit that the novelty of the presently claimed invention includes a method and apparatus of protecting electronic content by transmitting and renewing License Files without notifying a user (i.e. transparently) and not the particular way to transparently transmit the file itself.

In the present case, one of ordinary skill in the art has been provided with sufficient written description and possesses the knowledge to transparently transmit and renew files to a user and the Specification and claims meet the disclosure requirements under 35 U.S.C. § 112, first paragraph. Thus, Applicants respectfully request that the above rejection of independent claims 1 and 19-20 and 22 be withdrawn. Further, claims 2-9 and 17-18 depend from these independent claims and are allowable at least based on the arguments presented above.

#### **IV. Rejections under 35 U.S.C. § 112, Second Paragraph**

Claims 1-9, 17-20 and 22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. The Examiner contends that the Specification is silent regarding “renewing the parameters transparently” and “update said license file parameter transparently” and further does not provide



Similar to arguments presented above regarding the 35 U.S.C. § 112, first paragraph, rejections, the Specification is not silent as to the terms “transparently renewing” and “transparently updating.”

Further to the § 112, first paragraph, arguments above, one of ordinary skill in the art has the ability to transparently transmit a file to a user. Applicants are claiming a new and novel way of protecting electronic content by transmitting and renewing License Files without notifying a user (i.e. transparently) and not a method of transparent transmission.

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The Specification provides sufficient information to render the claims definite and sufficiently point out the claimed subject matter. Thus, Applicants respectfully request that the above rejection be withdrawn.

Claims 1, 19, 20, and 22 are rejected for containing conditional language which does not describe an alternate condition. Applicants respectfully traverse this rejection. Claims 1, 19, 20 and 22 have been amended from “if” to “when.” This step is now clear and unambiguous to one of ordinary skill in the art by removing the conditional language. Applicants respectfully request that the rejection be withdrawn.

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Claims 12-18 are rejected under 35 U.S.C. § 112, second paragraph, for not clearly defining the terms “license storage” and “content storage” recited in claim 12. Applicants respectfully traverse the rejection.

Claim 12 depends ultimately from claim 21. Claim 21 recites the elements “a license storage, operable to store said one or more license files on said user system; and a content storage, operable to store content items requested by said user and received from said content provider system.” The terms in claim 12 refer back to the elements described in claim 21, which are described with particularity and claim 12 recites that the user information is provided to three elements, the communication application, the license storage and the content storage. Applicants submit that claim 12 and its dependent claims 13-18 are clear to one of ordinary skill in the art. Applicants respectfully request that the rejection be withdrawn.

**V. Rejections under 35 U.S.C. §103**

Claims 1-9 and 11-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,073,124 to Krishnan et al. (“Krishnan”) in view of U.S. Patent No. 5,790,664 to Coley et al. (“Coley”) and further in view of the Applicants’ Admitted Prior Art. The Examiner states that Krishnan discloses a licensing system but does not transparently transmit or renew the license files. The Examiner further contends that Applicants admitted that the transparent transmission of data is “not a distinguishing feature between the Applicants’ claims and the state of the art” (Official Action dated June 22, 2005, paper no. 20050616, page 8) and that Coley discloses transparent renewal of the license file. Applicants respectfully traverse this rejection.

Contrary to the Examiner's contention, Applicants did not admit that transparent transmission of data is not a distinguishing feature of the invention. The Examiner cites to page 8, line 4 to page 9, line 20 of the Applicants' Appeal Brief dated December 20, 2004 to support his interpretation of the Applicants' statements. This portion of the brief is reproduced below:

A review of the prior art illustrates that the "transparent" handling of files is known and within the knowledge of one of ordinary skill in the art. Thus, the Specification, along with the knowledge of one of ordinary skill in the art enables one to make and practice the invention.

For example, U.S. Patent No. 6,519,624 ("the '624 patent" - attached hereto as Exhibit C), filed in the U.S. on April 28, 1999 (over 1 ½ years before the present application) discloses a data transmission/receiving system for exchanging data records between two computer nodes. The invention of the '624 patent determines the most efficient communications network between the two nodes to transmit data. The analysis is based on the size of the data and the speed of the network and the data is transmitted over the most efficient network. The "transmission takes place transparently for the user of the client application and other applications ... [Thus,] the solution taught by the invention is particularly user-friendly, and does not require any modifications to existing applications." The '624 patent, column 2, lines 6-11.

The data records disclosed by the '624 patent "can contain, for example, images, finished pages, video sequences or a multimedia document ... [and] can consist, for example, of control data that are exchanged between applications, correction data or status data concerning documents." The '624 patent, column 5, lines 32-37. The data is transmitted to and from the nodes and the users initiate the transfers. The disclosure of the '624 patent describes the method and system to switch between communications networks but provides no further information on how the switching and transmission is performed "transparently." The transparent nature of the invention is not described in detail but independent claims 12 and 14 of the '624 patent recite elements of "switch[ing] transparently" and "transparent switching" which suggest that there is enough support in the '624 patent to describe and enable the "transparent" element of the claims.

The transparent switching elements are supported by the disclosure in only two locations in the Detailed Description that describe performing actions "transparently." The '624 patent, column 4, lines 5-11, discloses that the "communications application CA1 hereby transmits a data record which is transmitted to it in the computer node CN1 for transfer to the computer node CN3, transparently for the applications A and the user U1, to the communications application CA3." Further, the "program module CRA delivers a data record transmitted by one of the computer nodes CN1 to CN2 to the computer node CN3, switches transparently between the different methods of receipt for such data records

to be delivered, and controls the receipt of such data records by means of the program modules WS and BCS.” The ‘624 patent, column 7, lines 3-8.

Appellants assert that one of ordinary skill in the art possesses the knowledge to transparently transmit a file to a user and that the claims of the ‘624 patent are enabled for one of ordinary skill in the art. The disclosure of both the present Specification and the ‘624 patent illustrate that the basic concept of transparently transmitting a file is well known, such that the mechanics of such a process need not be described in detail. Appellants submit that the novelty of the presently claimed invention includes a method and apparatus of protecting electronic content by transmitting and renewing License Files without notifying a user (i.e. transparently) and not the particular way to transparently transmit the file itself.

As can be seen above, Applicants only admitted that “the ‘transparent’ handling of files is known and within the knowledge of one of ordinary skill in the art,” and that “the present Specification and the ‘624 patent illustrate that the basic concept of transparently transmitting a file is well known.”

Applicants submit that the transparent transmission of files is known, the same way the standard transmission of files is known. However, the sentence seemingly overlooked by the Examiner is that “Appellants submit that the novelty of the presently claimed invention includes a method and apparatus of protecting electronic content by transmitting and renewing License Files without notifying a user (i.e. transparently) and not the particular way to transparently transmit the file itself.” Thus, the general ability of one of ordinary skill in the art to transparently transmit a file is known, but unless there is a teaching or motivation, one of ordinary skill in the art would not do it. The Examiner is using improper hindsight to contort the obvious meaning of the Applicants’ statements to assume that there is a teaching inherent in the above statement. Applicants submit that there is no teaching or suggestion, either literally or inherent, in the above statements to motivate one of ordinary skill in the art to choose the transparent transmission of files as opposed to notifying the user of the transmission.

In contrast, Coley stores license files in one location, on a license server maintained by the provider. *See, e.g.*, column 5, lines 13-15 and lines 54-55; column 6, lines 34-36; and column 7, lines 51-58. The system present on the user's computer is the client module 108 which:

sends a license validity inquiry request message to the license server 110 ... and queries the database 112 to determine whether a license record exists that corresponds to the client application 103 and computer 100. ... Pursuant to the query, a response message is generated and returned back to the client module 108 ... If the query finds a valid license record, the response message indicates the license record's existence and location in the database 112. ... If a license record is not located in the database 112, an appropriate response message is generated and returned. The presence of a record permits the client module 108 to enable, or to allow continued operation of (i.e., re-enable), the software application 102.

Column 7, lines 45-48 and column 8, lines 8-25. Coley's client module 108 does not transparently transmit or renew license files, but only transmits queries as to whether a license is stored elsewhere. The response back to the user is, in essence, a binary yes/no answer and not a license file that controls access to the content. This is further illustrated in Coley's Figure 2 and the supporting text in column 9, lines 1-27:

the client module 103 [sic 108] forms a license validity inquiry request message (step 208). ... After formation, the request message is sent to the license server 110 (step 210) over a public network ... If the query locates a record of a license for the request, a response message is returned having a license ID field comprising a pointer to the location of the license record in the database 112 (step 218). If the query does not locate a record of a license for the request, a response message is returned having a null indication in the license ID field (step 216). The response message is returned to the client module 108 (step 220) ... The client module 108 investigates the response message to determine whether the license ID field contains

a license ID (step 224). If the license ID field is null, the client module 108 fails to enable the software application, or disables it (step 226).

Further, Figure 2 illustrates the binary nature of the response, in the unnumbered element between steps 224 and 226. The unnumbered element illustrates the “yes/no” nature of the license ID field. Thus, Coley does not disclose the steps of “transparently transmitting the license file to the user;” “transparently renewing the parameters in the license file”, which by definition above, are on the user’s system since they were transmitted there; and “transparently receiving, by the user, the license file.” Coley only teaches storing the license files in a central database stored on a license server, not controlled by the user, and responding to a user’s request with an enable/disable response. A license file is never present on the user’s computer.

Coley discloses an additional embodiment that is also dissimilar to the present invention.

Coley discloses at column 22, lines 5-24:

In a non-connected or portable computer, such as a laptop, an exemplary licensing system in accordance with the invention can involve running an internal licensing module, or an agent component thereof, on the laptop computer itself. An exemplary embodiment of such an arrangement is depicted in FIG. 7. The agent component 706 of the licensing module 702 acts on behalf of a license server 712 during the periods that the portable computer 700 is out of communication with the license server 712. The agent component 706 can receive and respond to license validity inquiries generated by a client module 704 on software application 705 that is loaded on the portable 700 while the portable 700 is in transit. Audits of client application use can be stored in the cache 708 of the licensing module 702. When the portable 700 is re-connected to a network access point, such as an Internet 716 gateway, the client component 710 of the licensing module 702 can establish communication with the agent module 714 in the license server 712 to refresh the information in its cache component 708 and/or supply any audit data upstream.

Thus, Coley is placing a licensing module on the portable computer to send enable/disable messages in response to the client module’s query. Coley does not disclose that the licensing module 702 is

transmitted transparently to the portable computer. The only transparent transmission disclosed or suggested by Coley is for the validation request.

Additionally, Coley does not teach or suggest that the licensing module does anything except send a binary yes/no answer and further audits the client application and stores the uses in a cache. The audit data is then downloaded once the portable computer is reconnected to the network.

Furthermore, Coley teaches in the next paragraph that for disconnected systems, all licensing features, including renewals, happen with full notification to the user. The user's computer is tagged to indicate that the license module is present on the machine and the user is prompted to activate and renew the license. *See*, Coley, column 22, lines 28-41. Coley teaches that for disconnected systems, the user should be clearly notified of the presence of the license file, which is in contrast to the "transparent" elements of the present claims. Thus, Coley has no teaching or suggestion of transparent enforcement of content rights for disconnected systems.

Applicants respectfully submit that neither Krishnan nor Coley teach or suggest, alone or in combination, the "transparent" features of independent claims 1 and 19-22. Further, claims 2-9 and 11-18 depend from the independent claims and are allowable for the same reasons as the independent claims from which they depend. Accordingly, Applicants request that the rejection of claims 1-9 and 11-22 be withdrawn.



In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Respectfully submitted,

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